

## **REMARKS**

### **Response to Double Patenting**

Claims 35-37 were rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,712,775.

Claims 35-43 were rejected by the Examiner on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 8, 9, and 17 of U.S. Patent No. 6,454,727 to Burbank et al. in view of U.S. Patent No. 6,494,881 to Bales et al.

In response, Applicants have filed concurrently herewith a Terminal Disclaimer (Signed by Attorney) with respect to U.S. Patent No. 6,712,775 and U.S. Patent No. 6,454,727, correctly identified. This rejection is now moot in view of the Terminal Disclaimer.

### **Response to Claim Objections**

Claim 44 is objected to by the Examiner because of the following informalities citing "sidewall" as well as "side wall".

In response applicants have amended this claim to correct this informality.

### **Response to Claim Rejections Under 35 U.S.C. §112**

Claims 44-47 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### **Response to Claim Rejections Under 35 U.S.C. §102**

Claims 44-46 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,810,806 to Ritchart et al.. Ritchart et al. describes an inner member which extends out of a cut out or window in a probe member and which has an electrosurgical loop which cuts tissue. The reference fails to disclose a tissue acquisition device in which an electrically conducting cutting wire rotates out of a cut out (spaced proximal to the distal end) in a plane which traverses the longitudinal axis of the probe member. The reference cannot anticipate claims 44-46 because it does not teach every feature of claim 44.

### **Response to Claim Rejections Under 35 U.S.C. §103**

Claim 47 was rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,810,806 to Ritchart et al. as applied to claim 44 above and further in view of U.S. Patent No. 5,947,964 to Eggers et al.

Claim 47 depends from claim 44 and is directed to the feature of a tissue penetrating distal tip having an electrosurgical tissue cutting electrode to facilitate passage through tissue to a desired location within a patient's body. The Eggers et al. patent fails to make up for the deficiencies of the prior art cited against claim 44, so the combination of references fails to teach all of the claimed features and would, as a result, not render claim 47 unpatentable under 35 U.S.C. 103(a).

## Conclusion

Applicants believe that the pending claims are directed to patentable subject matter. Further consideration pursuant to the concurrently filed RCE and an early allowance are respectfully requested.

Respectfully submitted,

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